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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/660,276

09/11/2003

Scott L. Sullivan

C2

5011

7590

07/07/2005

Robert J. Hess
9 Miramar Lane
Stamford, CT 06902

EXAMINER

LE, THIEN MINH

ART UNIT

PAPER NUMBER

2876

DATE MAILED: 07/07/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/660,276

Applicant(s)

SULLIVAN ET AL.

Examiner

Thien M. Le

Art Unit

2876

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,3-12 and 14-24 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 1,3-12,14,15 and 18-24 is/are allowed.
- 6) ☒ Claim(s) 16 and 17 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ✓ 1) ☒ Notice of References Cited (PTO-892)
- ✓ 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 3/2005; 9/2003.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: ____.

DETAILED ACTION

The amendments filed on 3/2/2005 and 9/16/2004 have been entered. Claims 2 and 13 have been canceled. Claims 1, 3-24 remain for examination. The information disclosure statement filed on 3/2/2005 and 9/11/2003 have been entered.

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 15 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims of U.S. Patent No. 6,799,725 (herein after referred to as "the '725 patent"). Although the conflicting claims are not identical, they are not patentably distinct from each other because they essentially reciting the same limitation.

Claim 15 is rejected in view of claims 2 and 3 of the '725 patent. Similar to the claimed invention, claims 2-3 and their base claim recite:

1. A pill on which is imprinted micro barcode, said micro barcode containing information pertaining to any one of medication contents of the pill

Art Unit: 2876

and source identification of the pill.

2. A pill as in claim 1, wherein said source identification includes information selected from the group consisting of a manufacturer, a distributor, country of origin, and production lot number.

3. A pill as in claim 1, wherein said medical information is selected from the group consisting of potency expiration date, frequency of taking medication and dosage of medication in accordance with recommended treatment, side effects, conditions that adversely affect the potency and effectiveness of the medication, and instructions on treatment in the event of adverse reaction to the medication as may result from an unauthorized taking of the medication such as by an unsupervised child.

As can be seen, the patent protections have been granted to the earlier filed application.

Claim 16 is rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims of U.S. Patent No. 6,766,341 (herein after referred to as "the '341 patent"). Although the conflicting claims are not identical, they are not patentably distinct from each other because they essentially reciting the same limitation

Claim 16 is rejected in view of claims 1, 2, 11 and 19 of the '341 patent in that they recite:

1. A system of controlling the distribution of pills between a manufacturer and a consumer, said system comprising: a machine-readable code on a surface of each of said pills, said code conveying information relating to one of lot number, date of manufacture, date of expiration, location of manufacture, and National Drug Code number, and; a scanner adapted to read said machine-readable code of said at least one of said pills; and a scanner arranged to

Art Unit: 2876

scan said at least one of said pills during distribution between said manufacturer and said consumer so that said scanned pill may be identified.

2. A pill containing a drug and having a surface, said pill comprising: a machine-readable code located on said surface, said code relating to one of drug information, manufacturing information, and contraindications of the drug.

11. A method of obtaining information concerning a pill, comprising the steps of: scanning a bar code on a surface of the pill to obtain a result; accessing a database in response to the result being obtained from the scanning of the bar code; searching the database for a correlation with the result; making an indication based on the correlation to provide information concerning the pill; and making a determination with respect to suitability for administration of the pill based on the information.

19. A method as in claim 11, further comprising the steps of scanning a further bar code on a container of the pill; comparing the scanned further bar code and the result for a match; making an indication of the match in response to completion of the step of comparing.

As can be seen, the patent protections have been granted to the earlier filed application.

Allowable Subject Matter

Claims 1, 3-12, 14, and 17-24 are allowed.

The following is a statement of reasons for the indication of allowable subject matter: The prior art fails to disclose a method for verifying medication administered is

Art Unit: 2876

correct by scanning a bar code/machine-readable code on the surface of the pill, comparing with stored information, and generating alarm signals/indications as recited collectively in claims 1, 3-12, 14, and 17-24.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Thien M. Le whose telephone number is (571) 272-2396. The examiner can normally be reached on Monday - Friday from 7:30am - 4:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael G. Lee can be reached on (571) 272-2398. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Le, Thien Minh
Primary Examiner
Art Unit 2876
June 24, 2005